

Remarks

Claims 1-17 are pending.

Claims 1-17 are rejected by the Examiner.

Claims 1 and 8 were rejected under 35 USC 112, second paragraph. Claim 1 was rejected because of improper antecedent basis for the term 'the first computer.' This claim has been amended in a manner that the term now has antecedent basis. Withdrawal of this rejection with regard to claim 1 is requested.

Claim 8 was rejected because of the use of the term "MacIntosh," which is a trademark. While the use of a trademark may render the claim uncertain, the MPEP also states that the use of a trademark is 'not *per se* improper.' MPEP 2173.05(u). In this instance, where the use of the trademark does actually differentiate what the thing is, a computer that is compatible, it is submitted that the use is proper. However, to further the progress of the application, the specification has been amended to more clearly state that a MacIntosh compatible computer is one that runs the Mac OS and the claim has been changed to refer to the Mac OS. The term 'Mac OS' does identify the particular product. It is therefore submitted that these amendments overcome the rejection under 35 USC 112 and withdrawal of this rejection is requested.

Claims 1-17 are rejected under 35 USC 103(a) as obvious by Kubinsky, "Emulation of Ad-Hoc Networks on IEEE 802-11," in view of Chrysanthakopoulos (US Patent No. 6,968,307) 'Chrys'.

With regard to Kubinsky, the USPTO form PTO-882 lists the reference as "May, 2000." Applicants would appreciate verification of that date by the Examiner, as the only date listed in the copy provided to the Applicants merely states "2000" on the cover sheet. As this case was filed in 2000, verification of the exact date is requested.

Kubinsky discloses a method of emulating an ad-hoc network on the Berkeley network simulator (NS). The network simulator 'is a powerful tool for examining a wide

variety of *network protocols including TCP, routing protocols*....In this case, it is possible to examine *new protocols* with real data by just injecting the data to the simulator, or no emulator. (emphasis added)." See page 19.

Kubinsky is not directed to emulating operating environments, where the operating environment has a particular operating system. Kubinsky is not directed to an environment where the operating system makes any difference, as it is directed to communications between computers on a network with regard to the network protocols, not the devices that use the network to communicate.

Chrys is directed to allowing a PC to emulate virtual devices that do not exist in the system, or that are busy, until the device becomes available. The devices use the IEEE-1394 bus protocol and its associated drivers to emulate other devices. There is no emulation of an operating system. In the comments, with regard to claim 9, the office action states that the emulation of other operating systems is 'inherent' because not all PCs use the same operating system.

First, the system disclosed in Chrys does not interact with the operating system. The IEEE-1394 bus protocols have the same external interface regardless of the operating system. This is what enables other devices that are 'talking' IEEE-1394 to interact without regard to the file formats. See Chrys, col. 6, lines 21-29. Indeed, when one PC wants to access a second PC, the second PC acts like the device. See col. 6, lines 57-59.

Second, there is no discussion of emulation of other operating systems. The only operating system mentioned at all is Windows®. To assume that Chrys is universal to all operating systems is an impermissible extension of the disclosure of the prior art. The disclosure may easily be directed to devices that all use the same operating system, especially since the operating system is irrelevant to the operation of the disclosure of Chrys.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)." See the MPEP, 2112.

Claim 1 has been amended to include that the operating environment includes a particular operating system, as supported in the specification in several places, among them page 3. Claims 11 and 15 already require that the operating system be part of the emulated environment. See claim 11, "executing the emulator to access the data file to establish an emulated operating environment on the host computer to operate on the data file," for example, and claim 15, "executing an emulated operating system located on the emulation device on a processor of host computer having an original operating system."

The combination of references does not teach emulation of an operating system. As discussed above, Kubinsky is directed to emulating a network, with no regard to an operating system of the devices on the network, and Chrys is directed to emulating devices using a specific bus protocol, for which the operating system is irrelevant.

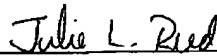
It is therefore submitted that claims 1, 11 and 15, and their respective dependent claims 2-8 and 10, 12-14 and 16-17 are patentably distinguishable over the prior art and allowance of these claims is requested.

No new matter has been added by this amendment. Allowance of all pending claims is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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